

III. REMARKS

Status of the Claims

Claims 1-3, 5-11, 18-25, 27 and 28 are presented for reconsideration.

The Office Action and Responsive Remarks

Applicant has considered the Examiner's comments set forth in the Office Action mailed August 31, 2009 and responds in detail below. Reconsideration of the application is respectfully requested in view of the following remarks.

Claims 1,2,5-7,18,20-25, 27 and 28 are rejected under 35USC103(a) based on the combined teaching of the reference Guilford et al, US Patent No. 7433929(Gui) and the cited reference Sugirtharaj, U.S. Patent No. 6678526(Sug). This rejection is traversed on the following grounds:

The combined teaching of Gui and Sug does not render claims 1,2,5-7,18,20-25, 27 and 28 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. In a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Although the case of *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S., 82 USPQ2d 1385 (2007), clarified the framework for the rejection of claims based on obviousness under 35 USC §103(a), a further operative question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." (82 USPQ2d at 1396. (from MPEP 2141). There must also be some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. (MPEP 2141, III(G)). In this case, it is submitted that the "predictable use" of the prior art elements does not lead to Applicant's claimed subject matter.

Claim 1 states:

“transmitting a second service request from the mobile station to a second network in response to said message received from the first network; and,

receiving the requested service from the second network when the data transmission service is not providable substantially in accordance with at least one of the service request and the terminal is not reachable via the first network.”

Independent claims 18, 21, 25, and 28 have equivalent language. The combined teaching fails to disclose or suggest these features.

The examiner, at page 4 of the office action, acknowledges that the cited reference Gui fails to disclose transmitting the second service request as stated above. In addition Gui fails to disclose that the requested service is received from the second network, when the data transmission service is not providable substantially in accordance with at least one of the service request and the terminal is not reachable via the first network.

The Examiner acknowledges further, at page 12 of the application that Sug fails to disclose that the requested service is received from the second network, when the data transmission service is not providable substantially in accordance with at least one of the service request and the terminal is not reachable via the first network. Based on the combined acknowledgements of the Examiner, Applicant submits that the cited reference Sug fails to remedy the deficiencies of Gui and that, therefore, the combined teaching fails to support the rejection based on obviousness.

A detailed review of the cited reference Sug further supports the patentability of applicant's claimed subject matter. Sug relates to a method for reserving a communication channel in a mobile telecommunication network. In Sug, after a mobile

station's initial attempt to place a call fails, because, for example of congestion in a first network, the mobile station requests reservation of a communication channel. A second network is used to forward the reservation request to the first network. In response to the request, an identification of the mobile station is placed in a queue of the first network for access to a communication channel in the first network. Once a communication channel becomes available in the first network, the first network reserves the channel for the mobile station (See e.g. Abstract). It is the first network that responds to the service request, not the second network as claimed in the subject application. Therefore, the Examiner's statement at page 6 that Sug "discloses transmitting the service request to another network" is not accurate the only service request transmitted by the other network is a request for a channel reservation from the first network (see column 4, lines 2-6).

In view of these deficiencies in the teachings of Gui and Sug, it is submitted that the combined teaching fails to disclose or suggest each and every limitation of the claims. As a result, the predictable use of the elements of the combined teaching of Gui and Sug cannot lead to Applicant's claimed subject matter.

Claims 3 and 19 stand rejected based on the combined teaching Gui and Sug in view of Roberts et al. (US Patent No. 7181201) under 35 USC §103(a). This rejection is traversed on the same grounds as indicated above. In particular the combined teaching of Gui, Sug, and Roberts fails to disclose or suggest the claimed features of independent claims 1, 18, 21, 25, and 28 as indicated above. These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims. The teaching of the reference Roberts fails to remedy the deficiencies of the combined teaching of Gui and Sug.

Roberts relates to routing a call to a called party's landline or wireless communication unit (see Abstract). In Roberts, the wireless and landline communication networks comprise computer usable medium that determines availability of the called party and

routes the call to the caller party's landline communication unit or to the caller party's wireless communication unit (Column 2, lines 33-37, 46-58). There is no disclosure or suggestion in Roberts related to a second service request that is transmitted from the mobile station to a second network in response to the message received from the first network, and that the requested service is received from the second network when the data transmission service is not providable substantially in accordance with at least one of the service request and the terminal is not reachable via the first network. Thus, the combination of Gui, Sug and Roberts does not disclose or suggest each element recited by Applicant in the claims and further, since each element of the claims is not disclosed, the predictable uses of the elements of the combined teaching do not lead to the claimed subject matter. A prima facie case of obviousness is not established.

Claims 8 and 9 are rejected under 35USC103(a) based on the combined teaching of Gui and Sug in view of McCanne et al. (US Patent No. 6901445). This rejection is traversed on the same grounds as indicated above. In particular the combined teaching fails to disclose or suggest the claimed features of independent claims 1, 18, 21, 25, and 28 as indicated above. These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims. The teaching of the reference McCanne fails to remedy the deficiencies of the combined teaching of Gui and Sug.

McCanne relates to redirecting system for service-to-client attachment in a virtual overlay distribution system (see Abstract). In McCanne, redirection is done inside one network where the ARN selects a candidate service node from its associated service cluster (Column 16, lines 48 - 62 and lines 8 -12). Therefore, the combined teaching of Gui, Sug, and McCanne fails to disclose or suggest that a second service request is transmitted from the mobile station to a second network in response to the message received from the first network, and that the requested service is received from the second network, when the data transmission service is not providable substantially in accordance with at least one of the service request and the terminal is not reachable via

the first network. Thus, the combination of Gui, Sug and McCanne does not disclose or suggest each element recited by Applicant in the claims and further since each element of the claims is not disclosed, the predictable uses of the elements of the combined teaching do not lead to the claimed subject matter. A prima facie case of obviousness is not established.

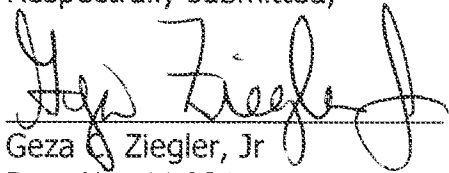
Claims 10 and 11 are rejected under 35USC103(a) based on the combined teaching of Gui and Sug in view of Sainton et al. (US Patent No. RE38787). This rejection is traversed on the same grounds as indicated above. In particular the combined teaching fails to disclose or suggest the claimed features of independent claims 1, 18, 21, 25, and 28 as indicated above. These grounds apply equally to the rejected dependent claims 10 and 11, each of which, by dependency, have the limitations described in the independent claims. The teaching of the reference Sainton fails to remedy the deficiencies of the combined teaching of Gui and Sug.

Sainton is directed to a radio frequency management system for reallocation of radio spectrum among a plurality of wireless communication networks using differing radio frequency modulation protocols and differing radio frequencies to communicate with a plurality of frequency and protocol agile portable radio devices each of which is responsive to portable radio device control signals to change its operating frequency and modulation protocol. There is no disclosure in Sainton, or the combination of Gui, Sug and Sainton related to a second service request being transmitted from the mobile station to a second network in response to the message received from the first network, and that the requested service is received from the second network, when the data transmission service is not providable substantially in accordance with at least one of the service request and the terminal is not reachable via the first network. Thus, the combined teaching of Gui, Sug and McCanne does not disclose or suggest each element recited by Applicant in the claims and further since each element of the claims is not disclosed, the predictable uses of the elements of the combined teaching cannot lead to the claimed subject matter. A prima facie case of obviousness is not established.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment any additional fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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Date

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